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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/441,191 11/15/99 ORAN

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EXAMINER
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TM02/0905

FOLEY, HOAG & ELIOT, LLP  
ONE POST OFFICE SQUARE  
BOSTON MA 02109

CHAMPAGNE, D	
ART UNIT	PAPER NUMBER

2162

DATE MAILED:

09/05/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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<p align="center"><b>Office Action Summary</b></p>	<p>Application No.</p> <p align="center">09/441,191</p>	<p>Applicant(s)</p> <p align="center">ORAN, DANIEL P.</p>	
	<p>Examiner</p> <p align="center">Donald L. Champagne</p>	<p>Art Unit</p> <p align="center">2162</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 June 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41-47 is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 12-15, 19-25, 27, 28, 34, 37, 39 and 40 is/are rejected.
- 7) ☒ Claim(s) 4-6, 9-11, 16-18, 26, 29-33, 35, 36 and 38 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner. *acceptable*
- 10) ☒ The drawing(s) filed on 15 November 1999 is/are ~~objected to by the Examiner~~.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- |   |  |
|---|--|
| 15) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____   |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 20) <input type="checkbox"/> Other:  |

DETAILED ACTION

*Claim Rejections - 35 USC § 102 and 35 USC § 103*

1. The following is a quotation of the appropriate paragraphs of 35 USC 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The following is a quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 7, 8, 14, 19, 21-25, 27, 39 and 40 are rejected under 35 USC 102(e) as being anticipated by Bezos et al. (US Pat. 6,029,141).
4. Bezos et al. teaches a method and apparatus for facilitating and tracking personal referrals, comprising (col. 2 lines 19-47): generating a unique identifier, a *unique associate ID* (col. 2 line 42), for the pairing of an individual (col. 1 line 21) and one offer to become an associate; sending to said individual an electronic-mail message that contains a web page (col. 2 lines 23-24) whose address or contents include said unique identifier or a transformation thereof; and providing in said web page instructions for building a website with referral links (col. 2 line 46), which reads on "providing in said web page a means of inputting the electronic-mail address of persons whom said individual wishes to refer".
5. Bezos et al. also teaches (claim 21) a participant database (*associate database 160*, col. 6 line 28), and the option to accept; (claim 23) a central controller (*web server 132*, p. 8 line 23); and (claim 25) a job offer and employment data, in the form of acceptance of the associate's application.
6. Claims 3, 12, 13, 15, 20, 28, 34 and 37 are rejected under 35 USC 103(a) as being obvious over Bezos et al.

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7. Bezos et al. does not teach (claims 3 and 15) determining if the individual has previously been sent an electronic-mail message about the offer. However, because Bezos et al. does teach that scrutiny of associate applications is important (col. 9 lines 46-47), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to determine if the individual has previously been sent an electronic-mail message about the offer, which would only occur if the previous offer had been withdrawn due to failure to meet standards set for associates.
8. Bezos et al. does not teach (claims 12, 13, 20 and 37) determining if the offer is still valid and sending electronic-mail messages to persons referred by the individual. Since there would be no point in distributing invalid offers, it would be obvious to determine if a prospective offer were still valid. Since the point of getting referrals is to communicate with the referred persons, particularly to verify their orders, this also would have been obvious to one of ordinary skill in the art, at the time of the invention.

#### ***Outstanding Issues and Examiner's Discussion***

9. Applicant's arguments filed 18 June 2001 (Paper No. 8) have been fully considered but they are not persuasive.
10. **ISSUES** – Applicant argues that the rejection part at the end of para. 4 above is not correct; that "referral links" (col. 2 line 46), are not, as examiner maintains, "means of inputting the electronic-mail address of persons whom said individual wishes to refer".

**EXAMINER'S DISCUSSION OF THE ISSUES** – The rejection compared precise word groups in the reference and in instant claims. The rejection also noted that the reference's "associate" is the "individual" of the instant claims. Examiner believed that that was sufficient explanation for one of ordinary skill in the art. Left unsaid was that "persons whom said individual wishes to refer" are customers who are going to make purchases from the merchant. This is obvious because it is from customer purchases that the associate receives a commission. Hence the subject "electronic-mail address" is that of the purchasing customer. E-mail is any exchange of text or computer files over a network (Computer Dictionary). Hence the purchasing customer's communication with the merchant web site is e-mail, and the purchasing customer must reveal their own site address, which is to say their e-mail address, in order to make the purchase. No merchant on the web is

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going to do business with an anonymous customer. The "referral links" at reference col. 2 line 46 are the means by which the customer communicates with and purchases from the merchant, which is to say that these referral links are a means of inputting the electronic mail address of the purchasing customer, which reads on the claim.

***Allowable Subject Matter***

11. Claims 4-6, 9-11, 16-18, 26, 29-33, 35, 36 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. Claims 41-47 are allowed.

13. The following is an examiner's statement of reasons for the indication of allowable subject matter.

A. (Claims 4-6 and 16-18) The closest prior art, Bezos et al., teaches a self-selecting method for recruiting individuals, i.e., a web site which is voluntarily selected by candidate individuals. There would be no point with such a system, and indeed it would not even be possible to, determine whether an individual had previously opted out of receiving electronic-mail messages (previously terminated the associate application process without submitting an application). Hence the inventive feature of the instant invention could not be anticipated by the closest prior art, and is not obvious from the prior art.

B. (Claims 9-11, 26, 36 and 38) The phrase "opt out" is disclosed at specification p. 3 lines 10-13 to mean *expressing* a preference to the central controller (the merchant server in the reference invention) to not receive further offers. Whereas the individual in the reference invention can opt out in the sense of terminating the application process, this would not constitute an expression of a preference not to receive further offers. (The individual in the reference invention could choose to again obtain an associates application from the merchant, which would constitute a further offer.) The reference neither teaches nor suggests opting out in the sense disclosed in the instant application.

C. (Claims 29-33 and 35) The reference does not teach or suggest referring a "participant", a potential associate in the reference invention, and tracking the referral. Associates would generally be reluctant to encourage other associates since they would be creating

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competition for themselves. In those cases where one associate found it to their advantage to encourage another person to become an associate, the associate would simply direct the second person to the on-line application process. The merchant would have no obvious reason for tracking these associate referrals.

D. (Claims 41-47) The reference invention does not utilize a database to determine at least one participant. The reference invention is intended for potential associates with special knowledge, in books, for example. It is not obvious that a worthwhile database of such people could be practicable.

14. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
16. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is (703)308-3331. The examiner's normal work schedule is 6:30 AM to 5 PM ET Monday through Thursday.

DLC  
30 August 2001

*Steve Gravini*  
**STEPHEN GRAVINI**  
**PRIMARY EXAMINER**